

Atty Dkt. No.: 10981377-4
USSN: 10/020,693

REMARKS

In view of the following amendments and remarks, the Examiner is respectfully requested to withdraw the rejections and allow currently pending claims 37 -43 and 46-72.

Applicant would like to thank Examiner for allowing claims 56-64 and 66-72.

Claims 47 and 65 have been amended to clarify that one of the claimed flow paths comprises the microvalve in question. This amendment is supported by the specification at paragraphs [0037] and [0038]. Accordingly, no new matter has been added. This amendment is made to advance prosecution, removes issues from appeal, and is not made for reasons of patentability.

Claims 47 and 65 were rejected under 35 U.S.C §112, second paragraph, as being indefinite. The Examiner states that it is unclear how a phase reversible material, which is said to be the micro-valve in claims 37 and 57, can subsequently be claimed as filling a flow path. Applicants have amended the application to clarify the relationships between the elements. This amendment is supported by the specification at paragraphs [0037] and [0038]. Accordingly, Applicants respectfully request reconsideration and withdrawal of the 112 second paragraph rejection of claims 47 and 65.

Claims 37-43 and 52-53 were rejected under 35 U.S.C §102(c) as being anticipated by Burns et al. (U.S. Patent No. 6,048,734).

According to the MPEP, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Additionally, the identical invention must be shown in as complete detail as is contained in the claim. See MPEP 2131.

A feature of the device presently claimed is a micro-valve. All of the rejected claims require a micro-valve. The micro-valve comprises a phase reversible material that is capable of opening and closing a multiplicity of times via the phase reversible material becoming more or

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less porous. Therefore, the micro-valve is capable of opening and closing a number of times. See paragraph [0032].

The '734 patent, on the other hand, does not teach a micro-valve. The '734 patent is directed to a device having a meltable material, such as solder, which when heated becomes a liquid, flows into a channel along a diaphragm, then cools and hardens thereby closing the fluidic flow of that channel. See column 11, line 57 to column 12, line 4. The "meltable material", i.e., solder, does not itself comprise the microvalve through which fluid flows, it is not capable of opening and closing a multiplicity of times, and it does not open or close by becoming more or less porous as does the phase reversible gel of the instant invention. Accordingly, the '734 patent does not teach a micro valve.

Because the '734 patent neither discloses a "micro-valve" nor a "micro-valve" comprising a "phase reversible material" capable of opening and closing, it can not be used to anticipate the present invention. Applicants, therefore, respectfully request reconsideration and withdrawal of the 102 (c) rejection of claims 37-43 and 52-53 over the '734 patent.

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CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone Mike Beck at (650) 485-3864.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,

Date: 5-17-05

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